

Response Under 37 C.F.R. 1.116

Applicant: Jeffrey Davis et al.

Serial No.: 09/812,754

Filed: March 20, 2001

Docket No.: 10010106-1

Title: SCROLLING METHOD USING SCREEN POINTING DEVICE

REMARKS

This Response is responsive to the Final Office Action mailed January 12, 2004. In that Office Action, the Examiner rejected claims 1, 2, 6-20, 23, and 24 under 35 U.S.C. §102(b) as being anticipated by Tiphane, U.S. Patent No. 5,805,161 ("Tiphane"). Claims 3, 4, 21, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tiphane as applied to claims 1 and 19, and further in view of Ishikawa, U.S. Patent No. 5,506,951 ("Ishikawa").

With this Response, Applicant respectfully traverses the Examiner's rejection of claims 1-4 and 6-24, and requests reconsideration of these claims. Claims 1-4 and 6-24 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §102 Rejections

The Examiner rejected claims 1, 2, 6-20, 23, and 24 under 35 U.S.C. §102(b) as being anticipated by Tiphane, U.S. Patent No. 5,805,161 ("Tiphane"). Independent claim 1 includes the limitations:

providing a first plurality of user selectable scrolling zones on the display screen, each scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a first direction, each of the scrolling zones in the first plurality being positioned substantially adjacent to a first edge of the display screen;

providing a second plurality of user selectable scrolling zones on the display screen, each scrolling zone in the second plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a second direction that is different from the first direction, each of the scrolling zones in the second plurality being positioned substantially adjacent to a second edge of the display screen, wherein the first edge is opposite to the second edge;

Applicant pointed out in the Response filed on October 20, 2003 that the Examiner did not appear to address the limitation in claim 1 that "the first edge is opposite to the second edge". In the Final Office Action, the Examiner replied as follows:

Applicant argues that the Examiner did not appear to address the limitation that "the first edge is opposite to the second edge." The Examiner addresses this limitation by referring to Figures 4A and 4B. (Final Office Action at para. no. 10, page 8).

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In the Response filed on October 20, 2003, Applicant addressed Figures 4A and 4B of Tiphane, and pointed out how the claim limitations were not taught or suggested. This discussion is summarized below for the Examiner's convenience:

Tiphane does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen as claimed in claim 1. Rather, Tiphane discloses a horizontal scroll box 450 and a vertical scroll box 440. (See, e.g., Tiphane at Figures 4A, 4B, and 5, and corresponding description). These scroll bars are not positioned on opposite edges of a display screen, and these scroll bars do not each include a plurality of scrolling zones as defined in claim 1.

Tiphane also discloses a pop-up box menu 420. (Tiphane at Figures 4A, 4B, and 5). Tiphane discloses that "[t]he pop-up box menu has nine buttons representing particular functions including a button for vertical scrolling 425 and a button for horizontal scrolling 430." (Tiphane at col. 5, lines 6-9). Tiphane does not appear to define what the functions are of the other seven buttons in the pop-up box menu. There is no teaching or suggestion in Tiphane that the other seven buttons in the pop-up box menu are related to scrolling functions. Tiphane's disclosure regarding the pop-up box menu with a single button for vertical scrolling 425 and a single button for horizontal scrolling 430 does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen as claimed in claim 1. (Amendment filed on October 20, 2003, at pages 7-8).

Thus, Applicant respectfully disagrees that Figures 4A and 4B of Tiphane teach or suggest the above-quoted limitations of claim 1. In the Final Office Action, the Examiner also stated that:

Applicant argues that Tiphane fails to disclose a first and second plurality of scrolling zones each corresponding to scrolling in different directions and position on opposite edges of a screen. Tiphane discloses a box menu on the screen in which a computer application may be scrolled depending on the scroll direction chosen. Applicant argues that the scroll bars are no position on opposite edges of a display screen. It is **inherent** that the scroll zones disclosed in Tiphane may be positioned in any zone area as a **design modification**.

Applicant argues that Tiphane fails to teach or suggest a first and a second plurality of scrolling zone corresponding to scrolling in different directions. Tiphane discloses nine boxes uses for representing particular functions, col. 5, lines 1-15. Tiphane discloses allowing a user to perform a desired scrolling function. Therefore, it is **inherent** that the seven other

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buttons **may be used** to provide additional scrolling functions. (Final Office Action at para. no. 10, pages 8-9) (emphasis added).

Applicant respectfully disagrees with the Examiner's conclusions that "[i]t is inherent that the scroll zones disclosed in Tiphane may be positioned in any zone area as a design modification" and "it is inherent that the seven other buttons may be used to provide additional scrolling functions." As the Federal Circuit has stated, "[i]nherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., v. Top-U.S.A. Corp.*, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). The Examiner appears to acknowledge that the claim limitations are not "necessarily present" in Tiphane by indicating that a "design modification" to Tiphane is needed, and that the seven other buttons "may be" used to provide additional scrolling functions. Thus, Tiphane does not explicitly teach or suggest each and every limitation of claim 1, and since the missing claim limitations are not "necessarily present" in Tiphane, claim 1 is not anticipated by Tiphane.

Applicant respectfully requests allowance of claim 1. If the Examiner maintains the rejection of claim 1, Applicant respectfully requests in accordance with M.P.E.P. § 2144.03 that the Examiner cite a reference to teach the further limitations of claim 1. In addition, dependent claims 2, 6-18, and 24, which further limit patentably distinct claim 1, are also believed to be allowable over the cited reference. The Applicant respectfully traverses the Examiner's rejection of claims 1, 2, 6-18, and 24, and allowance of claims 1, 2, 6-18, and 24 is respectfully requested.

Independent claim 19 includes the limitation "each user selectable scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and having a user selectable area defined by hidden boundaries". In the Final Office Action, the Examiner repeated the statement from the Office Action mailed on August 19, 2003, that "[a]s per independent claim 19 and dependent claim 20, they are rejected based upon similar rational as above independent claim 1 and dependent claim 2." (Final Office Action at para. no. 6, page 6). Like the Office Action mailed on August 19, 2003, the Examiner's statements regarding claim 1 and dependent claim 2 in the Final Office Action still do not address

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hidden boundaries. In the Response to Arguments section of the Final Office Action, the Examiner stated that:

Applicant argues that Tiphane fails to disclose “each user selectable scrolling zone associated with a scrolling technique and having a user selectable area defined by hidden boundaries”. Tiphane discloses that depressing the mouse calls up the pop-up box menu and upon selection of an item in the menu subsystem the pop-up box menu is removed from the display screen and the user moves the elevator bar of the selected scroll function to perform the desired scroll movement. **Tiphane does not disclose the boundaries of the zone or menu area are hidden**, however **it is inherent** that once selected the menu boundaries are not present on the screen and the user is able to further perform the selected scrolling technique. (Final Office Action at para. no. 10, page 9) (emphasis added).

The Examiner appears to have acknowledged that Tiphane does not explicitly teach or suggest each and every limitation of claim 19 by stating the “Tiphane does not disclose the boundaries of the zone or menu area are hidden.” The Examiner is again apparently relying on the concept of inherency. However, to rely on inherency, user selectable scrolling zones having a user selectable area defined by hidden boundaries would have to be “necessarily present” in Tiphane. *Trintec Indus., v. Top-U.S.A. Corp.*, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Such scrolling zones are not necessarily present in Tiphane. To the contrary, the boundaries of buttons 425 and 430 in pop-up box menu 420, and the boundaries of the elevator bars 445 and 455, are clearly visible in Figures 4A, 4B, and 5, of Tiphane. If the pop-up box menu is removed from the display screen as suggested by the Examiner, the buttons 425 and 430 would be removed and would not be “user selectable” as recited in claim 19. Thus, the pop-up box menu 420 does not include a user selectable area defined by hidden boundaries when the menu 420 is displayed, nor does the pop-up box menu 420 include a user selectable area defined by hidden boundaries when the menu 420 is removed. Similarly, the elevator bar 445 or 455 relied on by the Examiner does not include a user selectable area defined by hidden boundaries. Automatically re-positioning a screen pointer 435 from a pop-up box menu with visible boundaries to an elevator bar 445 or 455 with visible boundaries, as disclosed in Tiphane, does not teach or suggest user selectable scrolling zones having a user selectable area defined by hidden boundaries as recited in independent claim 19.

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In view of the above, independent claim 19 as amended is not taught or suggested by Tiphane. In addition, dependent claim 20, which further limits patentably distinct claim 19, is also believed to be allowable over the cited reference. Allowance of claims 19 and 20 is respectfully requested.

Independent claim 23 includes the limitations “determining . . . a first movement velocity . . .,” and “scrolling the displayed information on the display screen . . . in an amount based on the first movement velocity, the scrolling amount greater than the amount of movement of the screen pointer.” Applicant pointed out in the Response filed on October 20, 2003 that the Examiner did not appear to address these limitations in claim 23. In the Final Office Action, the Examiner replied as follows:

Applicant argues that the Examiner fails to address the limitation of determining a first movement velocity and scrolling the displayed amount in an amount based on the first movement velocity. The Examiner addresses this limitation as being disclosed in Tiphane as an elevator bar which performs the scroll function from the transmitted signal, col. 5, lines 55-58. (Final Office Action at para. no. 10, pages 9-10).

Col. 5, lines 55-58, of Tiphane, which is relied on by the Examiner, comprises a portion of one sentence. That one sentence reads as follows: “The jump subsystem 310 repositions, or “jumps,” the pointer 435 from the vertical scroll box 440 and transmits a signal through the central processing unit 210 to the menu subsystem 320 in the memory 260 indicating that the menu subsystem 320 should remove the pop-up box menu 420 from the display screen of the display 120.” (Tiphane at col. 5, lines 53-60). This cited portion of Tiphane does not teach or suggest determining a velocity from movement information provided by a screen pointing device, nor scrolling an amount based on such velocity, nor that the scrolling amount is greater than the amount of movement of the screen pointer.

In view of the above, independent claim 23 is not taught or suggested by Tiphane, and the Applicant respectfully traverses the Examiner’s rejection of claim 23. Allowance of claim 23 is respectfully requested.

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35 U.S.C. §103 Rejections

The Examiner rejected claims 3-4 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over Tiphane and further in view of Ishikawa, U.S. Patent No. 5,506,951 ("Ishikawa").

Claims 3 and 4 are dependent on independent claim 1. As described above with respect to claim 1, Tiphane does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen as claimed in claim 1. Ishikawa also does not teach or suggest these limitations of claim 1.

In view of the above, dependent claims 3 and 4, which further limit patentably distinct claim 1, are also believed to be allowable over the cited references, either alone, or in combination. The Applicant respectfully traverses the Examiner's rejection of claims 3 and 4, and allowance of claims 3 and 4 is respectfully requested.

Claims 21 and 22 are dependent on independent claim 19. As described above with respect to claim 19, Tiphane does not teach or suggest user selectable scrolling zones having a user selectable area defined by hidden boundaries as claimed in claim 19. Ishikawa also does not teach or suggest these limitations of claim 19.

In view of the above, dependent claims 21 and 22, which further limit patentably distinct claim 19, are also believed to be allowable over the cited references, either alone, or in combination. Allowance of claims 21 and 22 is respectfully requested.

Allowable Subject Matter

In light of the above, Applicant believes independent claims 1, 19, and 23, and the claims depending therefrom, are in condition for allowance. Allowance of these claims is respectfully requested.

CONCLUSION

Any inquiry regarding this Amendment and Response should be directed to Jeff A. Holmen at the below-listed telephone number or Pamela Lau Kee at Telephone No. (408) 553-3059, Facsimile No. (408) 553-3063. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11th day of March, 2004.

By Jeff A. Holmen
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